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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/042,018	01/07/2002	Gunter Stephan	A-2980	4907

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EXAMINER

RODRIGUEZ, JOSEPH C

ART UNIT	PAPER NUMBER
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3653

DATE MAILED: 10/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/042,018

Applicant(s)

STEPHAN, GUNTER

Examiner

Joseph C Rodriguez

Art Unit

3653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 8, 10, 11, 13, 16 and 18-20 is/are rejected.
- 7) ☒ Claim(s) 5-7, 9, 12, 14, 15 and 17 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 11 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 11, the language "braking/catching hook" (ln. 2) renders the claim indefinite as it is unclear what is meant by the symbol "/". Is the feature a braking hook, a catching hook, or both? Examiner recommends deleting this symbol and claiming the invention with particularity.

Regarding claim 16, the language "the flat sheet material is stored in the path thereof above a storage device to beyond a transfer center line" (ln. 4-6) renders the claim indefinite as this language is nonsensical. Examiner requests clarification.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 18-20 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Olivero (EP '098 A1)(Fig. 2, guiding device 62).

Claims 1-4, 13 and 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Dickhoff (US '842).

Regarding these claims, Dickhoff teaches a device (Fig. 4, 5) comprising paths (near arrows A, D with path D passing over transfer element 30) defining a common wedge-shaped region (nip between 2 and 3), a transfer region (near 7.1), and a guiding device (6h), wherein said guiding device is capable of deflecting a copy out of the path via an actuating movement and is capable of being adjusted into the path from a rest position (i.e., position outside of nip) (Fig. 4).

Hereinafter, Applicant is respectfully reminded that claim language consisting of functional language and/or intended use phrasing is given little, if any, patentable weight as the apparatus must merely be capable of functioning, or being used, as claimed. See MPEP 2112.02, 2114.

Claims 1, 4, 8, 10, 13, 16 and 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Oda et al. ("Oda")(JP '849 A).

Regarding these claims, Oda teaches a device (Fig. 1, 2) comprising paths (3, 4) defining a common wedge-shaped region (near 4a), a transfer region (top of 3a), and a tongue-like guiding device (15) formed as part of a storage device (top of 9), wherein said guiding device is capable of deflecting a copy out of the path via an actuating movement, is movable transitorily towards a transfer center line (i.e., middle between paths 3 and 4) and is adjustable into an engaged position (Fig. 1).

Claims 1, 4, 10, 13 and 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Nagayama et al. ("Nagayama")(JP '540 A).

Regarding these claims, Nagayama teaches a device (Fig. 2, 3) comprising paths (25, 33) defining a common wedge-shaped region (near 40), a transfer region (top of 43), and a tongue-like guiding device (43), wherein said guiding device is capable of deflecting a copy out of the path via an actuating movement and is movable transitorily towards a transfer center line (i.e., middle between paths 25 and 33) (Fig. 2).

Allowable Subject Matter

Claims 5-7, 9, 12, 14, 15 and 17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any references not explicitly discussed above but made of record are considered relevant to the prosecution of the instant application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph C Rodriguez whose telephone number is **703-308-8342**. The examiner can normally be reached on M-F during normal business hours (9 am – 6 pm, EST).


The examiner's **Personal fax number** is **703-746-3678**.

The **Official** fax phone number for the organization where this application or proceeding is assigned is **703-872-9326**.

The **UnOfficial** fax phone number for the organization where this application or proceeding is assigned is **703-306-2571 or 703-308-6552**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **703-308-1113**.

September 30, 2003


DONALD P. WALSH
SUPERVISORY PATENT EXAMINER
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